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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

DICUS, TAMRA

ART UNIT

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1794

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/581,953	YOKOCHI ET AL.	
	Examiner	Art Unit	
	TAMRA L. DICUS	1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 January 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-2, 4-7, and 10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

3. Careful revision is necessary to put the claims in proper form to convey the scope of the invention as Applicant intends. Instant claim 1 is not clear: where is the first impregnated paper layer formed by surface-layer paper impregnation? The first and second thermosetting resin is same, then identifying them as different "first" and "second" is not necessary.

4. Instant Claims 2, 5, and 10 are not clear because the structure is not clear. Particularly, it is not clear if "the surface-layer paper" referenced in claim 2 and the "impregnated blocking layer formed by the surface layer-paper" in claim 5 it is not clear if the surface layer-paper is the impregnated blocking layer or the first impregnated paper layer (e.g. formed by impregnating/impregnated "the surface layer-paper", is confusing because the first impregnated layer and the blocking layer comprise the same or maybe different surface layer-paper). Thus, it's not clear how many layers are present and where. It appears the phrases lack antecedent basis while attempting to create a new layer or ingredient, but relying on one paper in one layer which is confusing (because the blocking layer and first impregnated paper layers are different). It is not clear if there is an additional second paper layer within the blocking layer.

5. Further to Claims 4-6, this amendment is confusing as it is not clear how – “an independent blocking layer” further limits the blocking layer. The blocking layer is a layer so it is already independent. Further the blocking layer is comprised in the surface resin layer which makes it dependent it appears. It is not clear where the blocking layer is because in claim 1 it's on the entire surface of the surface resin layer, but in claim 6 it's on the surface layer-paper, which appears actually the first impregnated paper layer. It is not clear then if the surface layer-paper is a material or a separate layer from all other layers and where it is. Further in claim 6, it is not clear where the surface resin layer side is. The language is ambiguous. Similar issues exist with Claims 4-7.

Double Patenting

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 1-8, and 10 stand rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-3 of U.S. Patent No. 6514624 to Takemoto in view of Takeuchi et al, and over claims 1-10 of US 6558799 to Takeuchi in view of Takemoto.

8. Takemoto teaches the same structure as instant claim 1 except the primer layer between the pattern and surface layer is not recited as a blocking layer, however because it is in the same position, and below the surface resin layer of the same curing resin, it functions as a blocking layer. See patented claims. The substrate of Takemoto is not claimed, however, Takeuchi teaches impregnated paper substrates (implying two and second paper). It would have been obvious to one having ordinary skill in the art to have modified the claims of Takemoto to envision a blocking layer and impregnated paper substrate because Takeuchi teaches the same order, using similar materials and the paper substrate is conventional for decorative materials (5:1-60, Examples, and all patented claims). Takeuchi essentially teaches all the same elements and order, but teaches curing layers in three layers, one may serve as a blocking layer, and the substrate of impregnating paper is missing. Takemoto teaches an impregnated paper in Example 1 as a suitable substrate. It would have been obvious to one having ordinary skill in the art to have modified the decorative material of Takeuchi because Takemoto teaches impregnated paper in Example 1 as a suitable substrate, thus using more than one is obvious to further support the decorative material.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-8, and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takemoto in view of Malina et al.

Takemoto teaches per instant claim 1 (currently amended), a decorative material comprising a surface layer (3, 2b, 2a, FIGs. 2-3 and associated text/ patented claim 1) and a base material layer (1, FIGs. 2-3 and associated text/ patented claim 1, first impregnated paper) laminated and integrated on a rear surface thereof, wherein the surface layer comprises at least a surface resin layer (3, FIGs. 2-3 and associated text/ patented claim 1) comprised of a ionizing radiation curable resin, an impregnating blocking layer (sealer 4, patented claim 1, 6:49-68 - impregnating two part urethane resin (first and second resin) into substrate 1, thus functioning as impregnated blocking layer) for inherently blocking an ooze out of an uncured material (uncured from the upper layer) of a thermosetting resin, and an impregnated paper layer formed by a paper impregnated with the thermosetting resin and cured (1, FIGs. 2-3 and associated text, impregnated with same resin-thus first and second resins), laminated from a surface side; at least an uppermost surface of the base material layer comprises the impregnated paper layer (1, FIGs. 2-3 and associated text); and a pattern ink layer (2, FIGs. 2-3 and associated text). Primer layer 5 functions as an independent blocking layer that is not impregnated as it's of a coat of acrylic

and urethane resins (7:40-63). Takemoto employs a two-component urethane resin as the ionizing impregnating resin (6:55-60). Claims 1-8 are addressed. To instant claim 10, see 7:63-8:20, further that it is to be adhered is intended use.

Takemoto doesn't teach a second impregnated paper or impregnated in an inside surface resin layer side as claimed (claim 1-6).

Malina teaches a similar decorative material wherein any number of impregnated papers including and showing at least two below the substrate in FIG. 1 for balancing and depending upon the application the number of sheets are varied. See Abstract, 13:1-60.

It would have been obvious to one having ordinary skill in the art to have modified the bottom impregnated paper by supplying an additional second impregnated paper for balancing and variation dependent upon the end application as taught by Malina cited above. Note also: Though we are fully cognizant of the hindsight bias that often plagues determinations of obviousness, Graham v. John Deere Co., 383 U.S. 1, 36 (1966), we are also mindful that "the combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results," KSR Int'l Co. v. Teleflex Inc., 127 S. Ct. 1727, 1739 (2007). Thus, impregnation aids in making the layer that contains the resin (including all its sides) more sticky for adhesive bonding.

14. Claims 8-9 and 11-12 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Takemoto in view of Malina et al. and further in view of Rosenkranz et al.

The combination is applied above teaching the claimed invention.

Takemoto explicitly teach a two component urethane resin as per Claims 8-9 and 11-12.

Rosenkranz teaches a two component urethane acrylate impregnating resin (2: 31-42) comprised of alkylene oxides, such as ethylene oxide (3:1-33) in the B component for impregnating to strengthen textile webs and coloring purposes.

It would have been obvious to one having ordinary skill in the art to have modified the decorative material of the combination to include a urethane acrylate resin comprising ethylene oxide as claimed because Rosenkranz teaches a two component urethane resin assists as an impregnate used in webs for strengthening and coloring purposes (Abstract, 2: 31-42, 3:1-33).

Reference of Interest

US 6,162,264 to Miyazaki et al. teaches at col. 32, lines 55-68 impregnating inside surfaces of sheets to migrate into other porous sheets (like claim 6).

Response to Arguments

Applicant's arguments have been fully considered but they are not persuasive. Applicant argues the 112 rejection, however, the claims still are not clear. Applicant points to the specification, however, limitations from the specification (e.g. Figures, page 12, page 18, pre-cured state, pre-adhesion state) are not read into the claims. Applicant is invited to amend the claims to make clear limitations to understand perfectly what Applicant's invention is. As set forth prior, the claimed invention contains ambiguous language. Arguments to the Double Patenting (DP) rejection are noted but the same answer above is applicable to the DP rejection.

It is still obvious to impregnate resins in any layer for helping to stick and secure layers as provided by the prior art above.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to TAMRA L. DICUS whose telephone number is (571)272-1519. The examiner can normally be reached on Monday-Friday, 7:00-4:30 p.m., alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Larry Tarazano can be reached on 571-272-1515. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1794

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/D. Lawrence Tarazano/
Supervisory Patent Examiner, Art Unit 1794

Tamra L. Dicus /TLD/
Examiner
Art Unit 1794

March 7, 2009